



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Frederick M. Abbas

Serial No.: 09/941,377

Filed: August 28, 2001

For: SCENTED FOAM STRING FOR HUNTING

Attorney Docket No.: ABF 0104 PUS

Group Art Unit: 3752

Examiner: Davis D. Hwu

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal brief from the final rejection of claims 1-15 and 16-20 of the Final Office Action dated June 6, 2004. This application was filed on August 28, 2001.

I. REAL PARTY IN INTEREST

The real party in interest is A-Way Hunting Products, Inc., a corporation organized and existing under the laws of the state of Michigan, and having a place of business at 3230 Calhoun, Beaverton, Michigan 48612, as set forth in the assignment recorded in the U.S. Patent and Trademark Office on August 28, 2001 at Reel 012129/Frame 0898.

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II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellants, the Appellants' legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-20 are pending in this application. Claims 1-14 and 16-20 have been rejected and are the subject of this appeal. An amendment is submitted with this appeal to add additional claims 21-25 that depend from allowed independent claim 15.

IV. STATUS OF AMENDMENTS

An amendment after final rejection is filed with this appeal brief, and it has yet to be acted upon by the Examiner. The after final amendment is submitted to add claims 21-25 that depend from allowed independent claim 15. These claims are noted in Appendix A with the label "new".

V. SUMMARY OF THE INVENTION

The present invention relates to distributing a chemical composition for hunting animals (p. 1). The summary provided below relates to the rejected claims.

The chemical composition is dispensed in the form of a foam string. The foam string is propelled from a dispenser, such as a can, toward a target. The foam string is scented with environmental scents and/or animal scents that attract animals to the target or to mask human scents, such as earth, fox urine, or the like. (p.3)

One problem that hunters face is caused by hunters traversing too closely to the area around the target when applying the attracting scents thereto. The close proximity of the hunter to the target causes the target area to become overpowered by the human scents, effectively contaminating the area around the target and rendering the attractive animals scents ineffective.

The present invention overcomes this problem with a novel apparatus and method that allows the scented foam string to be propelled from the dispenser at a distance away from the target so that the hunter can lay the attractive scents around the target without having to touch or traverse the ground proximate to the target. This allows the hunter to attract animals to the target without contaminating the area around the target. (p. 7)

VI. ISSUES

1. Whether claims 1-6, 11-14, and 16-20 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S.P.N. 5,705,669 to Cox et al. (hereinafter the Cox patent) in view of U.S.P.N. 4,788,787 to Konietzki (hereinafter the Konietzki patent).

2. Whether claims 7-10 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over the Cox patent in view of the Konietzki patent and further in view of U.S.P.N. 4,771,563 to Easley (hereinafter the Easley patent).

3. Whether newly added claims 21-25 are allowable.

VII. GROUPING OF CLAIMS

1. Claims 3-6, 12-14, and 16-20 stand or fall together with respect to rejections under issue 1;
2. Claims 1, 2, and 11 stand or fall together with respect to the rejections under issue 1; and
3. Claims 7-10 stand or fall together with respect to issue 2.
4. Claims 15 and 21-25 stand or fall together with respect to issue 3.

VIII. ARGUMENT

1. **Claims 1-6, 11-14, and 16-20 are allowable under 35 U.S.C. § 103(a) over the Cox patent in view of the Konietzki patent**

The Examiner has rejected claims 1-6, 11-14, and 16-20 as being unpatentable over the combination of the Cox and Konietzki patents. With respect to this rejection, the Appellant submits that claims 3-6, 12-14, and 16-20 stand or fall together (Group 1) and claims 1, 2, and 11 stand or fall together (Group 2). Group 1 is patentability distinct from Group 2 in that Group 2 relates to preventing contamination of an area around a target, as opposed to Group 1, which relates to dispensing a foam string scented with hunting scents.

Group 1

The claims of Group 1 (3-6, 12-14, and 16-20) are patentable over the Cox and the Konietzki patents because the Examiner has improperly relied upon these references as a basis for an obviousness rejection.

The Cox patent relates to a can for dispensing a plastic foam string for play and decorative utility, as indicated in a portion of the Cox patent reproduced below.

A pressurized or "aerosol" can containing a composition of matter for producing a string of plastic foam is described. The plastic foam produced from the aerosol can is in the form of a cohesive plastic body sufficiently tacky to adhere to inert surfaces such as walls, windows or the like to support the weight of the foam, however, of insufficient tackiness to adhere with a force greater than the cohesive strength of the foam so that the foamed body can be readily removed from surfaces to which it lightly adheres. Such a combination has substantial play and decorative utility.

(Abstract, emphasis added)

The Konietzki patent relates to a device for unraveling a string scented with hunting scents.

This invention relates to a device for the propagation of a scent to lure deer or other wild game that are being hunted.

(Abstract, emphasis added)

The line 21 is then saturated to leave the desired scent upon withdrawing the now scent-laden line 21 from the interior of the scent propagation device 10 and laying the line out according to the area and the air currents. When the scent-laden line 21 is withdrawn from the interior of the scent

propagating device 10, the amount of liquid scent concentrate that is used is metered by adjustment of the valve 50, and to a lesser extent, the traversing of the line 21 through the bushing 26.

(Column 4, Lines 7-16, emphasis added)

The Examiner is relying upon one of ordinary skill in the art to provide the motivation for combining the cited references to teach an apparatus for dispensing a foam string scented with hunting scents. It is improper for the Examiner to do so. A *prima facie* case of obviousness cannot be established by relying on the level of ordinary skill in the art to suggest combining the cited references unless there is some “objective reason” to do so, as required by MPEP § 2143.01, which states the following:

Fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill in the art at the time of the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.

The only “objective reason” to combine the references comes from the Appellants’ application. Neither the Cox patent or the Konietzki patent provide an suggestion to include a hunting scent in a foam string.

In addition to needing an “objective reason” to combine the teachings of the references, the proposed combination must not render the Cox patent unsatisfactory for its

intended purpose and/or change its principle of operation, as indicated by MPEP § 2143.01, which states the following:

The proposed modification cannot render the prior art unsatisfactory for its intended purpose.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose then there is no suggestion or motivation to make the proposed modification.

The proposed modification cannot change the principle of operation of a reference.

If the proposed modification or combination of prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

The intended purpose of the Cox patent is to provide a foam string that has “play and decorative utility” and that allows the foam string to be used at parties or sprayed on walls to produce a decorative image. Modifying the Cox patent to include the scented string of the Konietzki patent changes its intended purpose, as the hunting scent of the Konietzki patent clearly fails to provide any “play or decorative utility” - it produces an odor that would be incompatible with “play” and “decorative ability”.

Not only does the Konietzki patent change the intended purpose of the Cox patent, it also changes its principle of operation. The Cox patent operates by dispensing the foam string from an aerosol can. The Konietzki patent dispenses the scented string by tying a string to a target and then unraveling the string from a spool by walking away from the target. This action requires some tensile strength in the string upon deployment. Not so with

the foam as dispensed from the claimed apparatus. In order to modify the Cox patent to include the hunting scented string of the Konietzki patent, the Cox patent must change from dispensing a foam string from an aerosol can to unraveling a string from a spool. Clearly, this modification necessarily changes the principle of operation of the Cox patent.

For the foregoing reasons, the claims of Group 1 (3-6, 12-14, and 16-20) are patentable over the Cox and the Konietzki patents because the Examiner has failed to establish a *prima facie* case of obviousness, as the Examiner has improperly combined the cited references.

Group 2

The claims of Group 2 (1, 2, and 11) are patentable over the Cox and the Konietzki patents because the Examiner has improperly relied upon these references as a basis for an obviousness rejection. In addition, the improper combination of these references still fails to teach the claimed invention.

The Appellants incorporate by reference the arguments set forth above with respect to the improper combination of the Cox and the Konietzki patents, and submit that the claims of Group 2 are patentable because the Examiner has failed to establish a *prima facie* case of obviousness.

Notwithstanding the improper combination of the Cox and the Konietzki patents, the proposed combination still fails to teach the claimed invention, as neither the Cox or the Konietzki patents teach dispensing a foam string at a distance away from a target so that an area around the target is not contaminated by the hunter, as recited in the claims of Group 2.

The only motivation for preventing contamination of the area around the target is derived from reading the Appellants' application. The Cox patent fails to provide any disclosure with respect to hunting applications. The Konietzki patent relates to hunting, but it fails to address the problem of the hunter contaminating the area around the target. In fact, the Konietzki patent necessarily requires the hunter to contaminate the area around the target. In order to apply the hunting string of the Konietzki patent, the hunter must traverse an area around the target because the hunter must tie the string to the target and then unravel the string from a spool by walking away from the target, as indicated in the portion of the Konietzki patent reproduced below.

The user may attach the end of the line 21 to a fixed object, such as a tree branch, and may even then unwind the spool 20 by walking away from the fixed object. The scent propagation device features a belt clip 15 so that the device may be clipped to a belt or other article of clothing, freeing the user's hands to carry other hunting equipment or to perform other tasks. By not having to handle the device, the user avoids the possibility of accidentally introducing human scent to the line.

(Column 3, line 32, emphasis added)

Notwithstanding the failure of either the Cox and the Konietzki patents to provide any suggestion, motivation, or incentive for preventing the area around the target from becoming contaminated, the Examiner maintains that it would be obvious to do so because to the Cox patent discloses the following:

The composition hereinafter provided has sufficient pressure to propel the string 6 inches or more from the nozzle and can provide more than 1/2 mile of string.

(Column 2, lines 36-37)

The Examiner misconstrues the teachings of the Cox patent. There is no suggestion in this portion of the Cox patent to prevent contamination of the area around the target. The mere ability to dispense foam string 6 inches or more fails to teach preventing contamination of an area around the target.

For the foregoing reasons, the Appellants submit the improper combination of the Cox and the Konietzki patents still fail to teach each claim limitation, as neither reference relates to dispensing a foam string at a distance away from a target so that an area around the targets is non contaminated by the hunter

2. Claims 7-10 are allowable under 35 U.S.C. § 103(a) over the Cox patent in view of the Konietzki patent and further in view of the Easley patent

The Examiner has rejected claims 7-10 (Group 3) as being unpatentable over the combination of the Cox, Konietzki, and Easley patents.

The claims of Group 3 (7-10) are patentable over the Cox, Konietzki, and Easley patents because it is improper for the Examiner to base an obviousness rejection on the combination of these reference.

The Appellants incorporate by reference the arguments set forth above with respect to the improper combination of the Cox and the Konietzki patents, and submit that the Easley patent fails to make-up for the deficiencies identified above. Accordingly, the claims of Group 3 are patentable for at least the same reasons.

3. **Claims 21-25 are allowable**

These claims are allowable because they depend from allowed claim 15.

IX. CONCLUSION

For the foregoing reasons, the Appellants respectfully submit that each rejections has been fully addressed and traversed, and that the case is in condition to pass to issue. The Board is respectfully requested to pass the case to issue.

The fee of \$165.00 as applicable under the provisions of 37 C.F.R. § 1.17(c) is enclosed. Please charge any additional fee or credit any overpayment in connection with this filing to our Deposit Account No. 02-3978. A duplicate of this notice is enclosed for this purpose.

Respectfully submitted,

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Enclosure - Appendix

X. APPENDIX A - CLAIMS ON APPEAL

1. A method for distributing a scented chemical composition for hunting animals, the method comprising:

providing a pressurized dispenser for pressure based dispensing of a foam string from a distance away from a target, the distance being sufficient to avoid an ambient environment being contaminated by human scent, the foam string including the scented chemical composition to attract animals or mask human scent or both; and

discharging the foam string toward the target.

2. A method for a hunter to hunt animals by dispensing a chemical composition that emits a scent from a dispenser, the method comprising;

configuring a can to dispense a liquid-gas foam string of encapsulated plastic resin, the string including the chemical composition;

providing the chemical composition so as to emit the scent for a selected period of time after being dispensed, wherein the scent attracts animals or masks human scent; and

dispensing the string from the can toward a target, the string being dispensed far enough away from the can that the hunter does not substantially contaminate an area around the target.

3. An apparatus for distributing a scented chemical composition for hunting animals, the apparatus comprising:

a pressurized dispenser for pressure based dispensing; and

a foam string dispensed by the dispenser, the foam string including the scented chemical composition for hunting.

4. The apparatus of claim 3, wherein the foam string comprises a liquid-gas foam string.

5. The apparatus of claim 3, wherein the chemical composition comprises a chemical composition that emits a scent for a selected period of time.

6. The apparatus of claim 3, wherein the chemical composition comprises a composition that attracts an animal.

7. The apparatus of claim 6, wherein the chemical composition includes urine of an animal.

8. The apparatus of claim 7, wherein the urine of the animal is synthetic.

9. The apparatus of claim 3, wherein the chemical composition comprises a chemical composition that masks human scent.

10. The apparatus of claim 9, wherein the chemical composition comprises an environmental scent selected from the group consisting of pine, earth, fox urine, and mixtures thereof.

11. The apparatus of claim 3, wherein the dispenser comprises a can having a enclosure for storing the chemical composition and a propelling assembly for propelling the chemical composition from its storage position within the enclosure so that the foam string can be dispensed toward a target from a distance away from being sufficient to avoid an ambient environment between the dispenser and the target from being contaminated by human scent.

12. The apparatus of claim 3, wherein the foam string adheres to a target.

13. The apparatus of claim 3, wherein the foam string is water-based.

14. The apparatus of claim 3, wherein the foam string comprises an encapsulated plastic resin.

15. An apparatus for distributing a scented chemical composition for hunting animals, the apparatus comprising:

a dispenser; and

a foam string dispensed by the dispenser, the foam string having a first outer layer having at least part of the chemical composition, wherein the first outer layer becomes a brittle crust layer that is delaminated to expose a second layer fresher than the first layer and having at least part of the chemical composition.

16. The apparatus of claim 3, wherein the foam string is sufficiently strong that the string may be applied to a target in a manner that allows environmental factors such as snow, wind and rain to impact and stress the string without substantially affecting its ability to remain applied to the target.

17. The apparatus of claim 3, wherein the foam string becomes brittle after a selected period of time.

18. The apparatus of claim 3, wherein the foam string remains flexible for a selected period of time.

19. The apparatus of claim 3, wherein the foam string dissolves slowly so that the string does not substantially dilute or dissolve into the earth until a selected period of time elapses.

20. The apparatus of claim 3, wherein the dispenser discharges the string toward a target that is located far enough away from a user that the user does not substantially contaminate himself, the sting, and an area around the target with human scent.

21. (new) The apparatus of claim 15, wherein the foam string is sufficiently strong that the string may be applied to a target in a manner that allows environmental factors such as snow, wind and rain to impact and stress the string without substantially affecting its ability to remain applied to the target.

22. (new) The apparatus of claim 15, wherein the foam string becomes brittle after a selected period of time.

23. (new) The apparatus of claim 15, wherein the foam string remains flexible for a selected period of time.

24. (new) The apparatus of claim 15, wherein the foam string dissolves slowly so that the string does not substantially dilute or dissolve into the earth until a selected period of time elapses.

25. (new) The apparatus of claim 15, wherein the dispenser discharges the string toward a target that is located far enough away from a user that the user does not substantially contaminate himself, the sting, and an area around the target with human scent.